UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/098,715	03/15/2002	Susan Forbes	124-00111	3038

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EXAMINER
QIN, YIXING

ART UNIT	PAPER NUMBER
2625	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

	Application No.	Applicant(s)
Office Action Summary	10/098,715	FORBES ET AL.
	Examiner	Art Unit	
	Yixing Qin	2625	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *15 March 2002*.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-23* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☐ Claim(s) _____ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on *15 March 2002* is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☒ All   b) ☐ Some * c) ☐ None of:

        1. ☒ Certified copies of the priority documents have been received.

        2. ☐ Certified copies of the priority documents have been received in Application No. _____.

        3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

I.   Claims 1-5, 8, 9, 12-17, and 20-22 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Aikens (U.S. Patent No. 6,216,113) in view of Dorfman (U.S. Patent

No. 6,449,651)

Regarding claim 1, Aikens discloses a method of enabling a computer network

user to print a task on a printer connected to the network via an associated printer

server, the method comprising:

The Aikens reference discloses a method for print job accounting including an

account access method in Fig. 5.

It does not explicitly disclose "maintaining a database of print credit tokens on the

printer server or another server connected to the network;"

However, Aikens does disclose in Figs. 1, 3, and 5 and column 4, lines 37-42

that various databases/data storages are provided in the system and that a credit

system can be used. Aikens also discloses in column 4, lines 23-35 that there are

various options for storing billing data. Since Aikens has a plurality of storage medium

in the printing device, workstations, or servers, the credit/billing/account information

could potentially be stored in any of those area depending on needs of the user (e.g.

whether data is to be backed up to a server or stored locally).

Therefore, it would have been obvious to one of ordinary skill in the art at the

time of the invention to have maintained a database in a particular server on the

network.   .

The motivation would have been to allow ease of access to credit/billing/account

information.

Therefore, it would have been obvious to use different storages in the Aikens

reference to obtain the invention as specified.

Aiken discloses the printer server querying the credit token database and

determining, in advance of printing the task, whether the credit token database holds

sufficient tokens to enable the task to be printed and, if it does, sending the task to the

printer and decrementing the print credit token number held in the credit token

database; (Fig. 5, an account is accessed and if it does not exceed the account credit

limit, then prints are printed)

maintaining, on a remote server, a database of printer servers and associated

printers; (Fig. 2, and column 2, line 66 – column 3, line 35 shows that the interface in

Fig. 2 can be used in any display, and can be remote from any system. Column 3, lines 15-22 shows access to any networked device including printers, faxes, scanner, and a variety of servers. This information has to be inherently stored somewhere. The location of storage would be dependent on the needs of the users of the network)

connecting the credit token database to the printer server database automatically or at the instigation of a user on the network; (Fig. 5 discloses that there is a check for the credits in an account. This connection to the account is automatic)

Aikens also discloses a verification technique for this invention but does not explicitly disclose the verification of the printer server.

However, the secondary reference, Dorfman, discloses in column 3, lines 19-41 at least one method of verification of a computer by another computer using a dongle attached to the computer to be verified. This can be easily adaptable to any computer network with two computers, which in this case is a printer server and another computer that contains a printer server database.

Aikens and Dorfman are combinable because both are in the art of data transfer and computer verification.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have incorporated a dongle verification system in the Aikens invention.

The motivation would have been for security purposes to ensure that a correct

printer server is obtaining private or secure information.

Therefore, it would have been obvious to combine Aikens and Dorfman to obtain

the invention as specified.

Aikens further discloses downloading print credit tokens to the credit token

database to update the database of print credit tokens after verification of the identity of

the printer server. (Fig. 5, items 158, 160, 162 - a credit amount is recalculated for the

account that is printed)

Regarding claim 9, this claim is similarly rejected as claim 1 above.

Regarding claim 2, Aikens discloses a method according to claim 1, wherein the

credit token database and the printer server database are a single database. (again,

from the discussion above, the Aikens reference has a plurality of computers/server with

data storage, so the choice of where to store the information would be a matter of the

needs of the network – i.e. security, ease of access of the information, etc.)

Regarding claim 3, Aikens discloses a method according to claim 1, wherein the

credit token database is located on a server remote from the printer server. (please see

the discussion in claims 1 and 2 above.)

Regarding claim 4, Aikens discloses a method according to claim 3, wherein the remote server is separate from the server hosting the printer server database. (please see the discussion in claims 1 and 2 above.)

Regarding claim 5, Aikens discloses a method according to claim 1, wherein each token represents an amount of printed material. (column 4, lines 23-42)

Regarding claim 8, Aikens discloses a method according to claim 5, wherein each token represents an amount of Paper (column 4, lines 23-42)

Regarding claims 14, 20, Aikens discloses a method according to claim 1, where verification of the identity of the printer server is achieved by use of a hardware key, or dongle attached to the printer server. (again, from claim 1 above, the Dorfman reference discloses a method for verification of identity of a computer using a dongle attached to the computer)

Regarding claims 15, 21, Aikens discloses a method according to claim 1, wherein the computer network is any one of a local area network, intranet, wide area network, and the Internet (Fig. 1, item 24 is a LAN)

Regarding claims 16, 22, Aikens discloses a method according to claim 1, further comprising restoring a credit token to the credit token database if the print fails to complete. (Fig. 5 – items 140, 144, 146 and 142. If any of 140, 144 or 146 is failed – i.e. the print fails to complete, the access to a printer is denied. However, the amount of print credits in the account is still kept the same amount as prior to the request for printing)

Regarding claims 17, 23, Aikens discloses a method in accordance with claim 1, further comprising providing a block token issuer; and

authorising blocks of credits to the printer server database for enabling print credit tokens to be supplied to the credit token database. (column 4, lines 36-42 of Aikens. The setup of predetermined credit limit for a group indicates that at some point credits had to be issued to the account. One method would be for a network admin to allocate it)

II.   Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aikens (U.S. Patent No. 6,216,113) in view of Dorfman (U.S. Patent No. 6,449,651) and further in view of Farrell (U.S. Patent No. 5,383,129)

Regarding claim 6, the Aikens and Dorfman references discloses ways to calculate printing costs and computer verification.

It does not explicitly disclose "A method according to claim 5, wherein each token represents a pixel of printing."

However, the tertiary reference, Farrell, discloses in column 8, line 52—column 9, line 13 that pixel counting and toner consumption can be two methods for calculating printing costs. Since Aikens has disclosed above that his method can be implemented either by a billing system or a credit system, one can use Farrell's disclosed methods of pixel counting or toner consumption in a credit based printing system.

All three references are combinable because they are in the area of data transferring and computer verification.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have used pixel counting or toner consumption as a method of calculating print costs.

The motivation would have been to use different criteria for calculating costs in order to come up with the most correct printing cost.

Therefore, it would have been obvious to combine all three references to obtain the invention as specified.

Regarding claim 7, the tertiary reference, Farrell, discloses a method according to claim 5, wherein each token represents an amount of printing ink. (please see claim 6 above)

III.   Claims 10-13, 18 and 19 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Aikens (U.S. Patent No. 6,216,113) in view of Dorfman (U.S. Patent

No. 6,449,651) and further in view of Ferlitsch (P.G. Pub. No. 2003/0090705)

Regarding claim 10, 18, the Aikens reference discloses a print billing/credit

system.

It does not explicitly disclose "a method according to claim 1, wherein the printer

server database queries the printer server for an identity string and compares this string

against a database of authorised identities; and

if the identity is found within the database then the printer server database

enables the credit token database to buy digital print credit tokens, receive information

on revised pricing plans or order additional consumables. "

However, the tertiary reference, Ferlitsch discloses in Fig. 3a that additional

funds can be added to the account after it has been properly authenticated with user

info and account info. It is known that the authentication using a password is done by

comparing an input value against a stored value. Since credit tokens are just a different

representation of money, the addition of credits would be just as obvious.

All references are combinable because Ferlitsch provides more functionality to

the Aikens reference.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have created a system where one can purchase additional tokens.

The motivation would have been to allow a user to print additional prints by purchasing more printing power.

Therefore, it would have been obvious to combine all three references to obtain the invention as specified.

Regarding claim 11, 19, Ferlitsch further discloses wherein the purchase of print credit tokens is achieved by authorising payment from an account associated with the respective printer. (Ferlitsch shows in 3A that the account had to be authenticated first prior to the addition of funds.)

Regarding claim 12 , Ferlitsch further discloses a method according to claim 10, wherein purchase of print credit tokens is achieved by authorising payment via credit card payment. (The Ferlitsch reference discloses that funds can be added to an account with insufficient funds for printing. However, Ferlitsch simply does not go into detail about a method to add the funds. But credit cards have been long known to be used for funding or purchasing, so it would have been obvious to one of ordinary skill to have used credit cards as a payment)

Regarding claim 13, Ferlitsch further discloses a method according to claim 10, wherein purchase of print credit tokens is achieved by authorising payment via account billing. (Similar to claim 12 above, the idea of billing an account has been well known as a way to charge for purchasing an item)

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yixing Qin whose telephone number is (571)272-7381. The examiner can normally be reached on M-F 9:30-6:00.
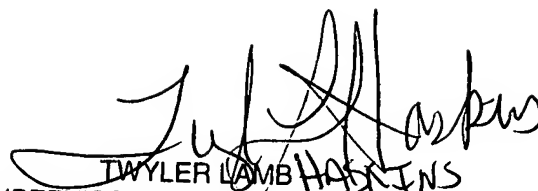
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler Lamb can be reached on (571)272-7406. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

YQ

TWYLER LAMB HASKINS
SUPERVISORY PATENT EXAMINER